

REMARKS

1. Summary of Office Action

In the Office action mailed December 17, 2004, the Examiner rejected claims 1 and 8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner also rejected claims 2, 4, 6-7, 9, 11, and 13-14 because these claims depend on either claim 1 or claim 8. Further, the Examiner indicated that claims 1 and 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, and that claims 2, 4, 6-7, 9, 11, and 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims.

2. Amendments to the Claims - Pending Claims

The Applicants have amended claims 1, 4, 6, 8, 11, and 13. Now pending in this application are claims 1-2, 4, 6-9, 11, and 13-14 of which claims 1 and 8 are independent.

3. Response to §112 Rejection

As noted above, the Examiner rejected claims 1 and 8 under 35 U.S.C. §112, second paragraph. In general, with respect to claims 1 and 8, the Examiner indicated it is unclear how the process of "selecting a synchronous base station to be handed off" is performed. In particular, the Examiner indicated (i) the step of selecting a base station is unclear, (ii) it is unclear how a base station is selected from a group of possible base stations, (iii) there is no indication where the "compressed message originates" or how this message is used to select a single synchronous base station to be handed off to, and (iv) it is unclear how the steps "d1)", "d2)", "d21)", "d22)" and "d23)" are used in selecting a synchronous base station.

The Applicants have amended claims 1 and 8 to clarify how a base station is selected from a group of possible base stations. The Applicants have amended claims 1 and 8 to clarify the compressed mode message is received through a common channel from a synchronous base station. And the Applicants have amended claims 1 and 8 to clarify that the steps associated with obtaining a long code state and a synchronous channel super frame timing are a step of the method for "performing a handoff from an asynchronous base station to a synchronous base station" instead of a step for "selecting a synchronous base station."

The Applicants submit that claims 1 and 8 have been rewritten to overcome the Examiner's rejection under 35 U.S.C. §112, second paragraph. Further, claims 2, 4, 6-7, 9, 11, and 13-14 depend from either claim 1 or claim 8, and include all of the limitations of either claim 1 or claim 8, and thus claims 2, 4, 6-7, 9, 11, and 13-14 have been rewritten to overcome the Examiner's rejection under 35 U.S.C. §112, second paragraph.


4. Conclusion

In view of the above amendments and remarks, the Applicants respectfully submit that claims 1-2, 4, 6-9, 11, and 13-14 are now in a condition for allowance, and respectfully request favorable reconsideration and allowance of the claims. If the Examiner would like to discuss this case, the Examiner is welcomed to contact the undersigned at (312) 913-3305.

Respectfully submitted,

Date: February 17, 2005

By:


Robert J. Irvine III
Reg. No. 41,865